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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/121,617 09/16/93 BACKSTROM

R 020325053

EXAMINER
HALEY, J

12M1/0210

ART UNIT PAPER NUMBER

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1201

DATE MAILED: 02/10/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on Sept 16, 1993 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 29-32 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 29-30 are rejected.
5. ☒ Claims 31-32 are objected to.
6. ☒ Claims 29-32 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Art Unit 1201

Claims 29-32 are pending. Applicant's Preliminary amendment dated September 16, 1993 has been received and entered. Accordingly, claims 1-28 are canceled.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such are cited to show the state of the art. Note the enclosed PTO-1449. As indicated, all references have been considered.

Claim 29 is generic to a plurality of disclosed patentably distinct species comprising for example, cyanoacrylamides or ketoacrylamides. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

During a telephone conversation with Benton Duffett on November 16, 1993, a provisional election of the species recited as the second species of claim 32 was elected with traverse. The claims are treated as per the provisions of MPEP 803.02.

Art Unit 1201

The Abstract of the Disclosure is objected to because such is of undue length and fails to be representative of the invention as now claimed. Correction is required. See M.P.E.P. § 608.01(b).

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Art Unit 1201

Claims 29 and 30 are rejected under 35 U.S.C. § 103 as being unpatentable over Lauerer, et al., US 3,278,448. Rationale:

Lauerer et al. teach compounds useful as ultraviolet filters which are embraced by the genus claimed in claims 29 and 30. Note that when the formula at line 45 of column 1 of Lauerer defines Ar as dihydroxy-halophenyl, R¹ is cyano, R³ is hydrogen and R² is COX (X is primary or secondary amine), the compounds fall within the claimed genus. One having ordinary skill in the art would have been motivated from this teaching of useful compounds to select among the substituents taught as equivalents to arrive at compounds useful for the reference utility. Absent a showing of unexpected properties, the compounds are obvious from Lauerer, et al. If applicant intends to rely on unforeseen results to show unobviousness, attention is directed to MPEP 716.

Claims 31 and 32 differ from the compounds of Lauerer, et al. by the nitro substitution on the phenyl ring. Such specific substitution is not taught nor suggested by the reference. Accordingly, these claims (compounds) are allowable over the art of record. However, claims 31 and 32 are objected to as depending on a rejected claim.

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Art Unit 1201

The disclosure is objected to because of the following informalities:

The specification fails to provide a Description of the Drawings in accordance with 37 CFR 1.74. The text at the top of page 19 is noted, however, a reference to and brief description of the drawings should include a subheading to such in the specification. Appropriate correction is required.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

Any inquiry concerning this communication should be directed to Examiner Haley at telephone number (703) 308-4548.

Haley: ach
February 08, 1994

Jacqueline Haley
Jacqueline Haley
Patent Examiner
Group 1200